



UNITED STATES PATENT AND TRADEMARK OFFICE

10/1
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,269	05/04/2001	Marina N. Papuashvili	123358.100	6313
21269	7590	12/01/2004	EXAMINER	
PEPPER HAMILTON LLP ONE MELLON CENTER, 50TH FLOOR 500 GRANT STREET PITTSBURGH, PA 15219			SCHEINER, LAURIE A	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/848,269	PAPUASHVILI
Examiner	Art Unit	
Laurie A. Scheiner	1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 October 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,9 and 10 is/are pending in the application.
 - 4a) Of the above claim(s) 9 and 10 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 5/4/01 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/6/01.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Applicant's election of Group I (claims 1-6) on October 15, 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *In re Rasmussen*, 650 F.2d 1212, 211 U.S.P.Q. 323 (C.C.P.A. 1981). *In re Wertheim*, 541 F.2d 257, 191 U.S.P.Q. 90 (C.C.P.A. 1976). Claims 1-6 are drawn toward a nucleotide sequence directing the synthesis of the complementary strand of a single stranded virus, and a nucleotide sequence containing at least a regulatory region operably linked to a structural gene encoding a toxin. The written description requirement under Section 112, first paragraph, sets forth that the claimed subject matter must be supported by an adequate written description that is sufficient to enable anyone skilled in the art to make and use the invention. The courts have concluded that the specification must demonstrate that the inventor(s) had possession of the claimed invention as of the filing date relied upon. Although the claimed subject matter need not be described identically, the disclosure relied upon must convey to those skilled in the art that applicants had invented the subject matter claimed. *In re Wilder, et al.*, 222 U.S.P.Q. 369 (C.A.F.C. 1984). *In re Driscoll*, 195 U.S.P.Q. 434 (C.C.P.A. 1977). *Utter v. Hiraga*, 6 U.S.P.Q.2d 1709 (C.A.F.C. 1988). *University of California v. Eli Lilly*, 119 F.3d 1559, 43 U.S.P.Q.2d 1398 (Fed. Cir. 1997). *Amgen Inc. v. Chugai Pharmaceutical Co. Ltd.*, 18 U.S.P.Q.2d 1016-1031 (C.A.F.C. 1991). *Fiers v. Sugano*, 25 U.S.P.Q.2d 1601-

1607 (C.A.F.C. 1993). *In re Bell*, 26 U.S.P.Q.2d 1529-1532 (C.A.F.C. 1993). The significance of conception and reduction to practice was further addressed by the court in *Fiers v. Sugano* where it was emphasized that “[c]onception is a question of law, reviewed *de novo* on appeal, and if inventor is unable to envision detailed chemical structure of DNA sequence coding for specific protein, as well as method of obtaining it, then conception is not achieved until reduction to practice has occurred, that is, until after gene has been isolated; thus, regardless of complexity or simplicity of method of isolation employed, conception of DNA sequence, like conception of any chemical substance, requires definition of that substance other than by its functional utility.” Thus, the courts have emphasized that the inventor must clearly and unambiguously identify the salient characteristics and properties of any given claimed nucleotide sequence. It is not sufficient to provide a vague reference to the biological activity of any given nucleotide sequence or merely a generic method of obtaining it.

Applicant's disclosure fails to provide adequate written support for the invention as claimed. That is, applicant's claim encompasses a nucleotide sequence directing the synthesis of the complementary strand of an RNA virus; the claimed sequence may be represented by any length and any sequence. However, the disclosure provides no discussion of the intended sequence. Moreover, the “operable” linkage of the gene encoding a toxin has not been described. Anti-virus agent cell entry has not been described. No examples of such have been set forth in the disclosure as instantly filed. As such, the disclosure fails to provide an adequate written description for subject matter as claimed.

The examiner contends that one of skill cannot reproduce that which has not been described. That is, it is evident that applicants were not in possession of that which is claimed at the time of the invention. It is well settled that the claimed subject matter need not be supported by an explicit, word for word recitation, but something more than a suggestion is

needed to satisfy the requirement for an adequate written description. As set forth in Lockwood v. American Airlines Inc., 107 F.3d 1565, 1571-1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997): It is the disclosures of the applications that count. Entitlement to a filing date extends only to that which is disclosed. While the meaning of terms, phrases, or diagrams in a disclosure is to be explained or interpreted from the vantage point of one skilled in the art, all the limitations must appear in the specification. Rather, a[n]... application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought... [A]ll that is necessary to satisfy the description requirement is to show that one is "in possession" of the invention... One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. . . Although the exact terms need not be used in haec verba, . . the specification must contain an equivalent description of the claimed subject matter. [Citations omitted]

It is not sufficient for purposes of the written description requirement of Section 112 that the disclosure, when combined with knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose. Each application must describe the claimed features. Thus, it is not enough for applicant to state that one of skill would know how to make or find a modified nucleotide sequence containing at least a regulatory region operably linked to a structural gene encoding a toxin wherein the nucleotide sequence encoding the toxin is positioned in an antisense direction. The specification is not enabled for the use of the claimed products and methods because the utility of the invention has not been set forth in the specification. The specification does not adequately enable the use of the claimed recombinants. The specification fails to establish that any of the anti-virus agents as claimed are effective in treating a viral disease. It is unpredictable that any of the instant recombinant agents will be effectively expressed in vivo following administration. The relationship between administering to a patient the instant anti-viral agent and anti-viral therapy

is unclear. Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in Ex parte Forman, 230 USPQ 546 (BPAI 1986) and reiterated by the Court of Appeals in In re Wands, 8 USPQ 2d 1400 at 1404 (CAFC 1988). These factors include 1) the quantity of experimentation necessary, 2) the amount of direction or guidance presented, 3) the presence or absence of working examples, 4) the nature of the invention, 5) the state of the prior art, 6) the relative skill of those in the art, and 7) the breadth of the claims.

Applying the above test to the facts of record, it is determined that 1) no declaration under 37 C.F.R. 1.132 or other relevant evidence has been made of record establishing the amount of experimentation necessary, 2) insufficient direction or guidance is presented in the specification with respect to selecting agents having the claimed functional feature, 3) there are no working examples which suggest the desired results of the method, 4) the nature of the invention involved the complex and incompletely understood area of molecular biology, 5) the relative skill of those in the art is commonly recognized as quite high (post-doctoral level), 6) the lack of predictability in the field to which the invention pertains is well recognized in the art, and 7) the scope of the claimed invention reads on a host of interrelated species and combinations for which, there would be no reasonable expectation of success.

Moreover, the scope of the claims is unduly broad due to the recitation of "nucleotide sequence directing the synthesis." Again, the specification does not support the broad scope of the claims which encompass all modifications and fragments of the claimed nucleic acids because the specification does not disclose the following:

- the general tolerance to modification and extent of such tolerance;
- specific positions and regions of the sequence(s) which can be predictably modified and which regions are critical;

-the specification provides essentially no guidance as to which of the essentially infinite possible choices of sequence is likely to be successful.

Thus, applicants have not provided sufficient guidance to enable one of ordinary skill in the art to make and use the claimed nucleic acids in a manner reasonably correlated with the scope of the claims broadly including any number of additions, deletions or substitutions and fragments of any size.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Scheiner, whose telephone number is (571) 272-0910. Due to a flexible work schedule, the examiner's hours typically vary each day. However, the examiner can normally be reached Monday thru Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (571) 272-0902. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (571) 272-1600.

Correspondence related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Official communications should be directed toward the following central fax number: (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

Laurie Scheiner/LAS


LAURIE SCHEINER
PRIMARY EXAMINER